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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,363	01/29/2007	Christopher Glen Clemens	70342/UST	1724

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EXAMINER

BROOKS, KRISTIE LATRICE

ART UNIT	PAPER NUMBER
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1616

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12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,363	Applicant(s) CLEMENS ET AL.	
	Examiner KRISTIE L. BROOKS	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. Claims 1-19 are pending.
2. Claims 3-4 and 7-12 are withdrawn from further consideration by the examiner, as being drawn to a non-elected species and claims 1-2 and 13-19 are presented for examination.
3. Receipt and consideration of Applicants amendments/remarks filed on September 8, 2008 is acknowledged.
4. Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-2 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkinson et al. (US 6,746,988).

Applicant claims a pesticidally active combination comprising a HPPD-inhibiting herbicide and an insecticide.

Determination of the scope and content of the prior art
(MPEP 2141.01)

Hopkinson et al. teach agricultural compositions comprising agriculturally active compounds, alkyl polyglycosides, surfactant systems, and basic compounds (see the entire article, especially the abstract). The surfactant systems help produce agricultural concentrates that exhibit good chemical and physical stability as well as excellent tank-mix properties (see the entire article, especially column 2 lines 46-55). The agriculturally active compounds can be used singly or in combination with 2,3,4,5,6,7, or more compounds. Examples of insecticides include acrinathrin, amitraz, DDT, methoxychlor

Art Unit: 1616

and salts thereof, herbicides include mesotrione, acetochlor, dicamba, glyphosate, metolachlor and salts thereof, and safeners include benoxachlor (see the entire article, especially column 9 lines 11-13 and 16-34, column 8 lines 11-67). Some examples of combinations include mesotrione, S-metolachlor and benoxacor or mesotrione, S-metolachlor, benoxacor and atrazine (see the entire article, especially column 9 lines 18-34). The compositions can be provided as a pre-mix composition and may be applied pre-emergence and/or post emergence to desired area (i.e. plants, soil, roots, seeds, stems, etc.) (see the entire article, especially column 10 lines 62-67, column 11 lines 1-6, and Examples 1-4).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Hopkinson et al. do not teach an exemplified formulation of the instant components.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make a formulation of the instant components.

One of ordinary skill in the art would have been motivated to do this because Hopkinson et al. teach the combination of the instant agrochemical actives in making improved chemical and physical compositions. Thus, it would have been obvious to one of ordinary skill in the art to make a composition with the instant components so as to achieve an enhanced stable composition for improved application to a desired area and for better preparation of commercial products in the agricultural industry.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

Response to Arguments

Applicant's arguments filed September 8, 2008 have been fully considered but they are not persuasive.

Applicant argues that the definition of "agriculturally active compounds" in Hopkinson et al. is incredibly broad and that out of all the possible combinations, one of ordinary skill would not reasonably be led to any combination within the scope of the instant claims. Applicant argues that Hopkinson et al. provides no specific and unambiguous teaching regarding the combination of herbicides with insecticides. Applicant further argues that such a selection is of an impermissible hindsight.

These arguments are not convincing. Although Hopkinson et al. do teach a variety of agrochemically active compounds and combinations that can be used, it would have been obvious for one of ordinary skill in the art to try the instant combination, given the finite number of agrochemical compounds identified and the

Art Unit: 1616

finite number of possible combinations. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Therefore, one of ordinary skill in the art would have good reason to pursue known options within his or her technical grasp, given the demand for agricultural compositions to exhibit excellent chemical and physical stability, which is highly desirable for commercial products, as suggested by Hopkins (see column 1 lines 8-17).

Although Hopkins et al. may not specifically exemplify the combination of insecticides and an HPPD-inhibiting herbicide, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the instant agrochemical compounds are disclosed in Hopkins et al. Hopkins et al. teach an agricultural composition comprising a surfactant system and agrochemical active compounds comprising mesotrione (an HPPD-inhibiting herbicide), insecticides, or mixtures thereof (see column 8 lines 11-59

Art Unit: 1616

and column 9 lines 16-34). Thus, the combination is taught and would have been obvious to one of ordinary skill in the art to try.

Next, Applicant argues that Hopkinson do not teach the HPPD-inhibiting herbicide in the form of an agrochemically acceptable salt.

This argument is not persuasive. Hopkinson et al. do teach that herbicides, such as, mesotrione (an HPPD-inhibiting herbicide), can be present in the salt form (see column 8 lines 37-59, especially line 59, and column 9 line 3).

Therefore, Applicant's arguments of nonobviousness are not persuasive and the rejection is maintained.

New Grounds of Rejection

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Schapira et al. (US 5,695,773).

Schapira et al. teach a phytosanitary composition comprising the combination of an oxynil and at least one active substance (i.e. herbicide, insecticide, fungicide, etc.) (see the abstract, column 1 lines 33-50, column 2 lines 10-21, and column 4 lines 5-33). Example 7 discloses a composition and method of application based on bromoxynil octanoate and primiphos-methyl (see Example 7). Example 9 discloses a composition

and method of application based on ioxynil octanoate and λ -cyhalothrin (see Example 9 in column 13-15).

EXAMPLE 9

Composition based on ioxynil octanoate and λ -cyhalothrin

Eight phytosanitary compositions according to the invention were prepared in the form of emulsifiable concentrates of which the respective formulations are shown in Table XV.

TABLE XV

	ioxynil octanoate (g/l)	λ -cyhalothrin (g/l)
Composition 1	240	25
Composition 2	240	50
Composition 3	240	100
Composition 4	120	100
Composition 5	240	12.5
Composition 6	240	25

TABLE XV-continued

	ioxynil octanoate (g/l)	λ -cyhalothrin (g/l)
Composition 7	240	50
Composition 8	240	100

Compositions 1 to 4 were applied by spraying in quantities of 0.25, 0.25, 0.25 and 0.5 l/ha, respectively, to plants of *Cleomepodium album*, *Melilotus incultus* and *Solanum elaeagnifolium* in pots, each composition 5 to 8 was applied by spraying in quantity of 0.5 l/ha to plants of *Galium aparine* in pots, and each of compositions 7 and 8 was applied by spraying in a quantity of 0.5 l/ha to plants of *Larrea tridentata* and *Veronica* sp. in pots at the 3 to 4 leaf stage in the doses indicated in Tables XVI A, XVI B and XVI C.

It is noted that the oxynil is not specified as an HPPD-inhibiting herbicide. However, it is the Examiner's position, that the herbicides taught in the prior art reference can inhibit the enzyme HPPD, absence evidence to the contrary.

Conclusion

9. No claims are allowed.

Art Unit: 1616

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616